

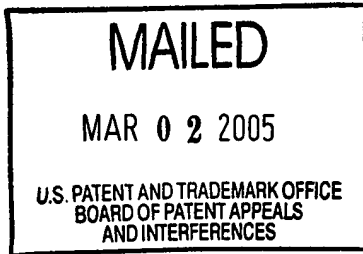
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC MATTHYS
and
KAZIMIR GASLIEVIC

Application No. 09/786,140

ORDER RETURNING TO EXAMINER



This application was received at the Board of Patent Appeals and Interferences on January 31, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith returned to the examiner. The matters requiring attention prior to docketing are identified below.

According to the examiner in the Final Rejection mailed September 23, 2003 (Paper No. 5), "claims 1, 2, and 4-27 are still rejected according to the previous office action [Paper No. 3 mailed February 6, 2003]" [page 3] and "[c]laim 3 is

Application 09/786,140

rejected under 35 U.S.C. 102(e) as being anticipated by Kawaguchi et al. US Patent No. 6,112,806" [page 4]. However, the "Grounds of Rejection" section appearing on page 3 of the Examiner's Answer mailed November 1, 2004 (Paper No. 9) states:

Original claims 1 through 7, 9, 10, 14, 17, 18 and 23 through 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawaguchi et al. US Patent No. 6,112,806. This rejection is set forth in prior Office Action, Paper No. 3. Claims 11 through 13, 15, 16, and 19 through 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawaguchi et al. U.[S] Patent No. 6,112,806 in view of Brown US Patent No. 4,702,312. The rejection is set forth in prior Office Action, Paper No. 3.

It should be noted that the Examiner's Answer fails to specifically address the rejection of claim 8. Correction is required.

Section 1208 of the Manual of Patent Examining Procedure (Eighth Edition, Rev. 2, May 2004) (MPEP) states:

Requirements for Examiner's Answer

The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

. . . .

(8) Claims appealed. A statement of whether the copy of the appealed claims

contained in the appendix to the brief is correct and, if not, a correct copy of any incorrect claim.

The Examiner's Answer mailed November 1, 2004 (Paper No. 9) does not comply with the above requirement.

On July 11, 2003, appellants filed an amendment to claim 3. It is noted that the language of claim 3 in the Appendix to the Brief differs from its last amended version. 37 CFR § 1.192(c)(9) (2003) requires that the Appendix to the Appeal Brief contain a correct copy of the claims involved in the appeal.

Section 707.08 of the MPEP states:

707.08 Reviewing and Initialing by Assistant Examiner

The full surname of the examiner who prepares the Office action will, in all cases, be typed at the end of the action

After the action is typed, the examiner who prepared the action reviews it for correctness. The surname or initials of the examiner who prepared the action and the date on which the action was typed should appear below the action. If the examiner does not have the authority to sign the action, he or she should initial above the typed name or initials. . . .

Application 09/786,140

The Examiner's Answer mailed November 1, 2004 (Paper No. 9) is deficient in that there is no signature or initials for Nihir Patel. Correction is required.

In addition, section 1208 of the MPEP further states:

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held. [Emphasis added.]

The Examiner's Answer mailed November 1, 2004 (Paper No. 9) does not comply with the above requirement because only one of the two conferee's signatures appear. Correction is required.

Accordingly, it is

ORDERED that the application is returned to the examiner:

1. for a determination regarding the status of claim 8;
2. for issuance of a supplemental Examiner's Answer which contains the "Claims Appealed" section;
3. for issuance of a supplemental Examiner's Answer which contains a correct copy of claim 3, or for notification to

Application 09/786,140

appellants to submit a new Appendix to the Appeal Brief which contains the corrected claim;

4. for taking corrective action regarding the signature or initials for Nihir Patel;


5. for taking corrective action regarding the appeals conference; and

6. for written notification to appellants regarding the action taken; and

7. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:


DALE SHAW
Program and Resource Administrator
(703) 308-9797

cc: Eric Matthys
1263 San Antonio Creek Road
Santa Barbara, CA 93111

DS/psb/pb